



UNITED STATES PATENT AND TRADEMARK OFFICE

cl
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,907	09/07/2004	Noriko Shimozone	Q83226	6781
23373	7590	04/14/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			CHU, YONG LIANG	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/506,907		SHIMOZONO ET AL.	
	Examiner		Art Unit	
	Yong Chu		1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,7-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-6, and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. JP02-61835.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/7/04, 12/8/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-11 are pending in this application.

Priority

This application is a 371 of PCT/JP03/02632, filed on 6 March 2003.
Acknowledgement is made of Applicant's claim for Japan Patent Application 1542/02 under 35 U.S.C. § 119(a-d), filed on 7 March 2002.

Response to Lack of Unity

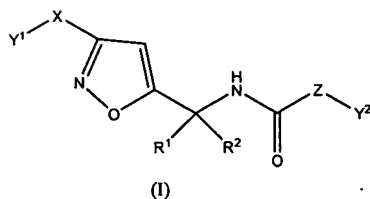
The response to the restriction request with election of Group I and species of compound IV-34 described at page 51 of the specification *without traverse* by Applicants' representative, Bruce E. Kramer dated on 23 March 2006, has been considered.

In accordance with M.P.EP 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or

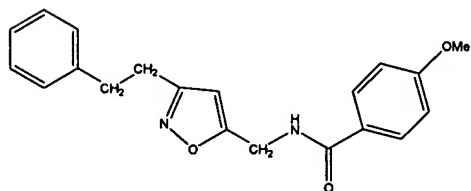
to otherwise include the limitations of the product claims. ***Failure to do so may result in a loss of the right to rejoinder.***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The election of **Group I**, directed to products of formula (I),



and the specific compound IV-34,



, depicted on page 51 of the specification, is

acknowledged.

Status of the Claims

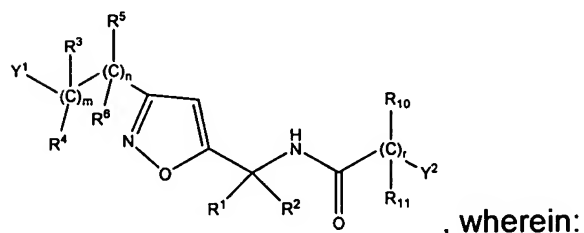
Claims 1-11 are pending in this application. Claims 1-2 (in part), 3-4, 7-9 and 11 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention as the direct result of election of Group I without

Art Unit: 1626

traverse. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and will require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

The scope of the invention of the elected subject matter is as follows:

Compounds of more specific formula according to Group I of the election,



R^1 - R^6 and R^{10} - R^{11} each represent H or C_1 - C_6 alkyl... as defined in claim 1;

m , n , and r each represent 0, 1, 2, or 3;

Y^1 and Y^2 each represent the group as defined in claim 1.

Therefore, claims 1-2 (in part), 5-6, and 10 are ready for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "may be substituted" for Y^1 and Y^2 in claim 1-10 is a term which renders the claim indefinite. The term "may be substituted" is not

Art Unit: 1626

defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "...Z is a single bond (i.e. the case that m and n are 0 in the formula (1))" is inconsistent among Z, m and n. Formula (1) is about X not Z. Therefore, Examiner interprets Z as X as a single bond in view of m and n for examining purpose of claim 10.

Claim Rejections - 35 USC § 102

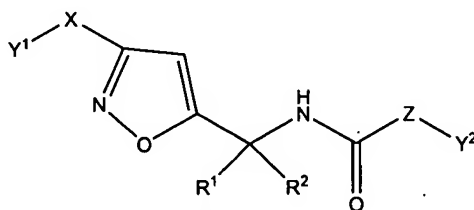
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102 (b) as being anticipated by Schwab *et al.*, WO 95/24397 (1995).

Applicants instant elected invention in claims 1 and 2 teaches compounds of

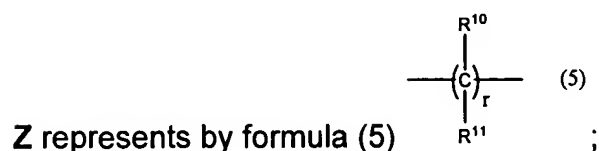
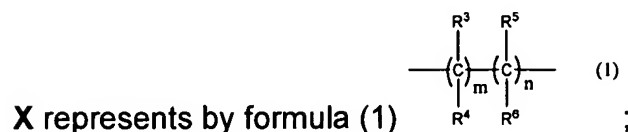


formula I,

(I)

, depicted in claim 1, wherein:

Art Unit: 1626

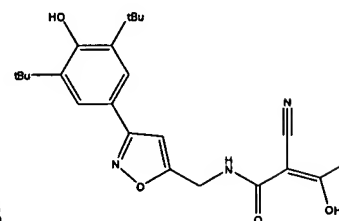


R^1 - R^6 and R^{10} - R^{11} each represent H or C_1 - C_6 alkyl... as defined in claim 1;

m , n , and r each represent 0, 1, 2, or 3;

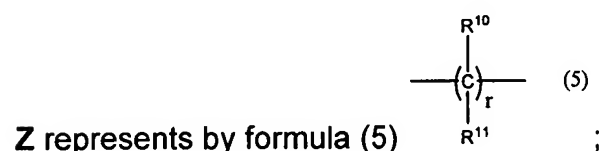
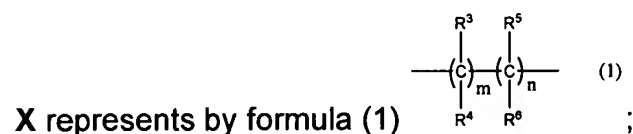
Y^1 is a lower alkyl, a phenyl group may be substituted,... as defined in claim 1;

Y^2 is a lower alkenyl group may be substituted, ... as defined in claim 1.



Schwab *et al.* teach specific compound of Example 53

on page 55 of WO 95/24397, read on the instant claims 1-2 wherein:



R^1 - R^2 , and R^3 - R^4 is H,

m is 0;

n is 0;

r is 0;

Art Unit: 1626

Y¹ is a substituted phenyl;

Y² is alkenyl.

Conclusion

No claims are allowed.

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759.

The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

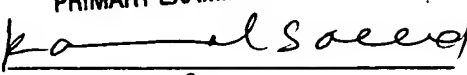
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1626



Yong Chu, Ph.D.
Patent Examiner
Art Unit 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



for Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626